Remarks

Applicants have carefully reviewed the Office Action dated September 27, 2005. Claims 1-57 are pending. Claim 7 has been withdrawn. Claims 1-6 and 8-57 have been rejected.

35 U.S.C. § 102 Rejection

Claims 1-3, 9-11, 20-31 and 35-36 were rejected under 35 U.S.C. § 102(e) as being anticipated by Boyle et al. (U.S. Patent No. 6,537,294). Applicants respectfully traverse the rejection.

Boyle et al. do not disclose each and every element of the claimed invention. For example, claim 1, recites in part that "the elongate tubular member [has] a first opening from the distal end" and that this "first opening [has] a diameter at least as great as the first outer diameter of the medical device." The preamble recites that the first outer diameter is of the medical device in a first, closed state. This generally means that the catheter has a distal opening at least as large as the medical device in its closed state. Boyle et al. appears not to disclose such a distal opening.

Boyle et al. describe the sheath 60 of Figure 7 as having "the same features of the embodiment previously described" except that "the guidewire lumen 62 is a short lumen incorporated into the sheath 60 to create a rapid exchange type delivery sheath." Col. 9, ll 34-38. The sheath previously described is delivery sheath 10 of Figures 1 and 8. This sheath has a "distal end of the filter lumen 16 [that] has a region 48 with a diameter less than the diameter of the main portion of the filter lumen 16. Col. 8, ll. 55-58. That this region 48 has a diameter that is less than that of the filter (i.e. medical device) in its closed position is made clear in the next paragraph. "This reduced diameter region 48 of

the filter lumen 16 should not prevent the sheath from retracting over the filter device 12 since the delivery sheath 10 can be made from a material which will stretch somewhat as the sheath 10 is being retracted over the filter device." Col. 9, ll. 5-9. It is clear from this description that the distal opening is not at least as great as the first outer diameter of filter in its closed position.

Further, this region 48 with a reduced diameter is essential to the invention. Among other functions discussed in the paragraph beginning at col. 8, ll. 51, the "reduced region 48 on the filter lumen 16 also helps to prevent the filter device 12 from extending into the guidewire lumen and prevent the coil tip 52 of the guidewire 28 from becoming tangled with the primary guide wire 14 as the components are being manipulated into the patient's vasculature." Col 8, l. 66 though col. 9, ll. 4. Making the diameter of region 48 greater than the diameter of the filter in its closed state eliminates this function of the device. Thus, any modification that enlarges region 48 such that the distal opening is greater than the diameter of the filter renders the invention of Boyle unsatisfactory for its intended purpose. It is of course well established that if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. See MPEP 2143 and *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

Because Boyle et al do not appear to disclose at least a "first opening having a diameter at least as great as the first outer diameter of the medical device" where the first opening is "a first opening from the lumen at the distal end" and consequently do not disclose each and every element of the invention of claim 1, applicants submit that claim 1 is in condition for allowance. As claims 2-6, and 8-9 depend from claim 1 and contain

additional elements, applicants submit that these claims are in condition for allowance as well.

Applicants note a few of the advantageous a distal opening diameter as claimed has over that of Boyle et al.—the larger distal opening diameter may permit easier or more rapid back-loading of medical devices into sheathes and may permit easier flushing of air from the sheath prior to insertion.

Independent claims 10, 25 and 37 recite similar language and applicants submit they are allowable for the reasons discussed above. Claim 10 recites "the elongate tubular member having a first opening from the lumen at the distal end" and "the first opening having a diameter at least as great as the first outer diameter of the medical device." Likewise, claim 25 recites "an elongate member having a first opeing from the lumen at the distal end" and "the first opening having a diameter at least as great as the first outer diameter of the medical device." Finally, claim 37 recites "the elongate member having a first opening from the lumen at the distal end" and "the first opening having a diameter at least as great as the first outer diameter of the medical device." As noted above, Boyle et al. do not appear to disclose these elements. Applicants therefore respectfully submit that these claims are in condition for allowance. As claims 11-24, 26-35 and 38-57 depend from claims 10, 25 and 37 respectively and contain additional elements, applicants submit that these claims are in condition for allowance as well.

Reexamination and reconsideration are respectfully requested. It is submitted that all pending claims are currently in condition for allowance. Issuance of a Notice of Allowance in due course is anticipated. If a telephone conference might be of assistance, please contact the undersigned attorney at 612-677-9050.

Respectfully submitted,

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By their Attorney,

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